

### **REMARKS**

Claims 22 and 26 are canceled without prejudice, and therefore claims 14 to 21 and 23 to 25 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

As to paragraph three (3) of the Office Action, the informalities and typographical errors have been corrected as suggested. Accordingly, withdrawal of the objections is respectfully requested.

With respect to paragraph four (4), claims 14 to 26 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 14 and 21 (and their dependent claims) are to a simulation system and a method for performing a useful, concrete, and tangible utility and are therefore statutory. By using such a system or method using distinct memory locations instead of shared ones, the process of model-to-code transformation, compilation, and linkage, and executable download need not be repeated. Further, signal connecting ports can be established, modified, or removed (even during a running experiment) without perceptible delay.

Claim 25 (claim 26 is canceled) is written as a Beauregard claim, and therefore also represents statutory subject matter.

Applicants do not understand why these issues are being raised in view of the recent Precedential Opinion of the Board of Patent Appeals and Interferences, *Ex parte Carl A. Lundgren* (paper no. 78), Appeal No. 2003-2088 (U.S. Patent Application Serial No. 08/093,516) (case Heard April 20, 2004). To the extent that the Office maintains this rejection in view of *Lundgren*, it is respectfully requested that the Office explain exactly how the rejections are supported in view of the Board's precedential *Lundgren* opinion.

Still further, it is respectfully submitted that claims 14 (system), 21 (method), and 25 (computer readable medium) do satisfy Section 101 since they are directed to a system, a method or a computer readable medium which are patentable and since there is utility. The *Lundgren* opinion and MPEP (2106 and 2107) regarding the Examination Guidelines for the utility requirement address these issues. It is also respectfully submitted that the reasons advanced in support of the rejection are simply not supported by either the Examination Guidelines or more importantly the case law, and that a *prima facie* case has not been presented as required by Sections 2106 and 2107 of the MPEP.

In this regard, the Board of Patent Appeals — in reversing another Examiner as to the law of State Street — has stated that claimed subject matter having a “practical application” is § 101 statutory subject matter if it represents a “useful, concrete and tangible result” under State Street, and has further stated that the Federal Circuit's reasoning in State Street is “intended to be broadly construed”. See *Ex parte Donner*, 53 U.S.P.Q.2d 1699, 1702 (Bd. Pat. App. & Int. 1999).

It is therefore respectfully requested that the Section 101 rejections of claims 14, 21, and 25 (and their corresponding dependent claims) be withdrawn in view of the precedential Lundgren opinion of the Board of Patent Appeals and Interferences (in its opinion).

As to paragraph five (5), claims 14 to 26 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Accordingly, claims 14, 15, 16, and 19, as now presented, obviate the antecedent basis issue. Also, independent claims 14, 21, and 25, as presented, better clarify the simulation and verification of a control system under development, while claims 22 and 26 are canceled without prejudice. Withdrawal of the indefiniteness rejections is therefore respectfully requested.

As to paragraph six (6), claims 14 to 26 were rejected under 35 U.S.C. § 102(e) as anticipated by Brayton et al., U.S. Patent No. 6,823,280.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(e), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any

anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

As to claims 14, 21 and 25 (claim 26 is canceled), the Brayton reference does not identically disclose (nor even suggest) the claim feature of a "plurality of simulation processes," nor the "corresponding memory modules," as provided for in the context of these claims. Further, the Brayton reference does not identically disclose (nor suggest) the claim feature of "copying signal values from one module memory location to another distinct module memory location," as provided for in the context of the claimed subject matter. This replication enables several benefits as described in the specification, which are not taught by the Brayton reference.

Accordingly, claims 14, 21 and 25 are allowable, as are their respective dependent claims.

### CONCLUSION

It is therefore respectfully submitted that claims 14 to 21 and 23 to 25 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

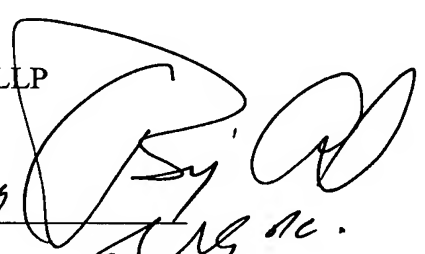
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